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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,225	11/05/2003	Harry H. Lu	RANPP0348USA	7995
7590 07/14/2005 RENNER, OTTO, BOISSELLE & SKLAR, LLP Nineteenth Floor 1621 Euclid Avenue Cleveland, OH 44115-2191			EXAMINER KIM, EUGENE LEE	
			ART UNIT 3721	PAPER NUMBER

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,225

Applicant(s)

LU ET AL.

Examiner

Gene Kim

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 6/15/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. Claims 1-3, 5 are rejected under 35 U.S.C. 102(b) as anticipated by Fuss et al as discussed in paragraph 2 of the previous office action. Fuss shows the claimed subject matter. Regarding manipulating formed strips of dunnage, the examiner notes that the claims do not specifically recite that “formed strips of dunnage” are being supplied. In addition, the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. See in re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935).

***Claim Rejections - 35 USC § 103***

2. Claims 4, 8, 9, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al in view of Cruz et al or Wischusen, III as discussed in paragraph 3 of the last office action. Regarding claim 23, the examiner maintains that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. See in re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935). Furthermore, the actual configuration of the tab is nothing more than one of numerous configurations a person of ordinary skill in the art would find obvious. See in re Dailey, 149 USPQ 47 (CCPA 1976).

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3. Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fuss et al as discussed in paragraph 4 of the last office action.

Applicant's arguments filed 6/15/2005 have been fully considered but they are not persuasive. In response to applicants arguments regarding primary reference Fuss et al, claim 1 does not specifically recite that formed strips of dunnage are being manipulated. Furthermore, this limitation is regarding the actual product that is nugatory in apparatus claims as discussed supra. Lastly, the examiner is entitled to interpret the claims in a broad context in light of the specification. Claim 1 sets forth as a "dunnage producing system" which infers that dunnage is being manufactured and is not already formed. The examiner is also interpreting "dunnage" to read on the strips in Fuss et al which are going to be made into dunnage.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gene Kim whose telephone number is (571)272-4463. The examiner can normally be reached on Tuesday-Friday 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



EUGENE KIM  
PRIMARY EXAMINER